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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,561	03/27/2001	Larry L. Hood	155694-0054	2600
1622	7590	07/28/2004	EXAMINER	
IRELL & MANELLA LLP 840 NEWPORT CENTER DRIVE SUITE 400 NEWPORT BEACH, CA 92660			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/819,561	Applicant(s) HOOD, LARRY L.	
	Examiner david shay	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 5-31 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,32,33 and 36-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>September 29, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 35 (cancelled in the amendment submitted April 2, 2003) has been renumbered 45.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al.

See Figure 4; the Abstract; and column 3, line 58 to column 4, line 4.

Claims 1-4 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Knopp et al. Bille et al teaches denaturing tissue. Knopp et al disclose a medical system that can denature a cornea comprising laser (item 87), a stepper motor (item 41), and a lens (item 17 and 23). It would have been obvious to employ the laser of Sand in the device of Knopp et al, since this provides recurvature without affecting surface tissue, as taught by Bille et al or to employ the focal point displacement mechanism of Knopp et al, since Bille et

al provides no particulars of the mechanism for moving the beam, thus producing a device such as claimed.

Claims 32, 33, 36-38, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Klopotek . Bille et al teaches denaturing eye tissue. Klopotek teaches configuring the intensity of an incident laser beam. It would have been obvious to the artisan of ordinary skill to employ the laser of Bille et al in the device of Klopotek, since this provides a non destructive recurvature or to employ the intensity configuring mask of Klopotek in the device of Bille et al, since it will work equally well work any laser, thus producing a device such as claimed.

Claims 1, 40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with Bille et al, as applied to claims 1-4 and 40 are above, and further in view of L'Esperance Jr. L'Esperance Jr. teaches an ocular surgery device which provides for the movement of the beam focal point in a circular pattern about the cornea at a predetermined diameter. It would have been obvious to the artisan of ordinary skill to employ a scanner with a scan pattern as taught by L'Esperance, Jr., since this is a useful pattern for ophthalmic surgery and to produce the pattern with the diameter of 6-8 millimeters, since L'Esperance, Jr. says only that the distance needs to be 'predetermined' and using a distance of 6-8 millimeters would place it outside of the optically used portion of the cornea, which will prevent visual distortions as is notorious in the art, thus producing a device such as claimed.

Claims 37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bille et al in combination with Klopotek as applied to claims 32, 33, 36-38, 42 and 45 above, and further in view of L'Esperance, Jr. L'Esperance, Jr. teaches providing a circularly scanned spot

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which denatures tissue. Thus it would have been obvious to the artisan of ordinary skill to employ the intensity modifier of Klopotek to produce the intensity pattern of the spot in the method of L'Esperance, Jr., since the outputs of laser such as used by L'Esperance, Jr. have a non-uniform intensity distribution, thus producing a method such as claimed.

Applicant's arguments with respect to claims 1-4, 32, 33, and 36-44 have been considered but are moot in view of the new ground(s) of rejection.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DI

July 20, 2004



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330